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GARCIA, ERNESTO				
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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/528,544
Filing Date: September 26, 2005
Appellant(s): HOLSCHER, WINFRIED K. W.

Barry L. Kelmachter
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed April 6, 2009 appealing from the Office action mailed April 30, 2008.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

WITHDRAWN REJECTIONS

The following grounds of rejection are not presented for review on appeal because they have been withdrawn by the examiner. The 35 USC 103(a) rejection of claims 29, 31-34, 36, and 37, as being unpatentable over Rixen et al., 5,192,145, in view of Shell, 4,775,259, has been withdrawn since claim 29 has been amended to

include the limitations of allowable claim 30, assuming the workpieces are claimed as part of the connecting device.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

No evidence is relied upon by the examiner in the rejection of the claims under appeal.

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 29 and 31-39 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claims 29 and 35, the metes and bounds of the claim is unclear. It is unclear whether any of the workpieces are part of the claimed invention? Note that the limitation "for connecting a first workpiece having an interior space to a second workpiece" in lines 2-3 inferentially suggests that both the clamping screw and the

sleeve, recited in line 4, are intended for this particular purpose. However, the limitation "the clamping screw having a shank with engages in a longitudinal groove of the first workpiece" in lines 5-6 suggests that the first workpiece is positively recited. Accordingly, is the first workpiece part of the connecting device? For purposes of appeal, the examiner assumed the first workpiece being part of the connecting device as the claim requires the shank engaging in the longitudinal groove of the first workpiece.

Regarding claims 31-34, the claims depend from claim 29 and therefore are indefinite.

Regarding claims 36-39, the claims depend from claim 35 and therefore are indefinite.

(10) Response to Argument

Appellant argues, at the bottom of page 10, that in the instant case, one would readily understand the connecting device to be used to joint to workpieces together and the manner in which the components of the connecting device interact with the workpieces. In response, the claim can not be set in both ways since one would contradict the other. In other words, if the connecting device is actually "interacting" with the workpieces, then the connecting device brings in the workpieces as part of the invention otherwise the workpieces would be merely intended to interact with the connecting device as set forth in the preamble and therefore the workpieces would not

be part of the connecting device but inferentially recited. The limitation "the clamping screw has a shank which engages in a longitudinal groove of the first workpiece" in claims 29 and 35, lines 5-6, requires the shank engaging in the groove of the first workpiece. This interaction positively requires the first workpiece, which is the environment, as part of the connecting device, in particular, if this is to be met in any infringement. When the workpiece is being positively recited, the question remains whether the connecting device is still "for connecting a first workpiece" as recited in the preamble.

Appellant further argues that the claimed invention just "comprises a clamping screw and a sleeve". In response, this is not all the claim requires. The claim further requires a shank of the screw "engages in a longitudinal groove of the first workpiece". Clearly, this limitation cannot be ignored. The claim also requires, in lines 24-26, the "outer ribs" be "assigned to radial grooves in a groove bottom and in facing surfaces of the longitudinal groove". It is clear that the groove is the one in the first workpiece. Accordingly, the claims are rendered indefinite and thus require clarification. Further, it should be noted that it is the body of the claim that determines the scope of the claim and not the preamble.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Ernesto Garcia

/Ernesto Garcia/

Examiner, Art Unit 3679

/Victor MacArthur/

Primary Examiner, Art Unit 3679

Conferees:

Heather Shackelford /Heather Shackelford/

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